<h1 align="center">REMARKS AND EVIDENCE</h1>

Applicant has carefully reviewed Examiner's interpretation of the cited Freedman (U.S. Patent 4,839,829) prior art as presented in Examiner's February 25, 2004 Final Office Action (Paper 8). Respectfully, Applicant simply cannot agree with the strained and conclusory interpretation of Freedman presented by Examiner. In many instances, Examiner improperly attributes features and functions to the Freedman device which are not found in the Freedman disclosure and cites to words out of context in an attempt to substantiate the claim rejections.

Most importantly, however, Examiner continues to ignore, without explanation or justification, the requirement that Applicant's claims be interpreted in accordance with the relevant portions of Applicant's specification *as required by 35 U.S.C. § 112, 6th Paragraph*. Applicant implores Examiner to carefully and closely reexamine the Freedman disclosure with a fresh eye in light of the following remarks and evidence.

Responding, in order, to the below identified sections of the February 25, 2004 Final Office Action, please make of record the following remarks and evidence .

Response to Amendment

Applicant acknowledges Examiner's withdrawal of the objection to the drawings and notes the first objection to the drawings remains as stated by the Notice of Draftsman attached to Paper 2.

Response to Arguments

Introduction

For completeness of the record, and to preserve its rights on appeal, Applicant wishes to address several factually incorrect allegations and attributions regarding the Freedman device made in Examiner's "Response to Arguments." Although some of these incorrect allegations and attributions are not directly relevant to the allowability of Applicant's claims, they evidence a continued misunderstanding of the Freedman disclosure which forms the flawed basis of Examiner's current 35 U.S.C. § 103(a) rejections and past 35 U.S.C. 102(b) rejections. Examiner again is respectfully requested to closely and carefully review the Freedman patent and Applicant's entire Specification in light of the following comments .

Freedman Cannot Print Products

Examiner maintains the contention that the Freedman disclosed device can print products. Examiner finds support for this contention by citing column 4, lines 25-41 and column 10, lines 24-32. Applicant agrees that Freedman discusses printing of products (the general field of both Applicant's and Freedman's inventions), but such discussion must be read in the context of Freedman's full disclosure, and not with improper hindsight conveniently designed to support Examiner's position. In that light, it is quite evident that Freedman's disclosure does not support Examiner's proposition that the Freedman device prints products. Much to the contrary, the entire purpose and essence of Freedman's disclosure is a device which *merely assists* with the printing of a product. Printing of products under Freedman's device is done by a printing facility, long after Freedman's device has done its job, as discussed below.

Freedman's device is a central computer which communicates with a print requester and a printing facility. Various printing facilities transmit to the central computer administrative and pricing data regarding the types of jobs those facilities can print. A print requester transmits to the central computer information regarding a desired printing job. The central computer analyzes the information from the print requester and compares it to the information it received from the various printing facilities. The central computer then offers the print requester a selection of printing facilities which are qualified to print the job along with cost estimates for printing the job using various printing equipment at each printing facility. The print requester may then choose which printing facility and printing equipment he or she wishes to use, or the print requester may let the central computer automatically choose an appropriate facility and printing equipment. Once the printing facility selection is made, the central computer transmits the printing job information to the printing facility. The printing facility, entirely separate and distinct from Freedman's device, then produces the printed work. Thus, it is factually incorrect, and inconsistent with the Freedman disclosure, to state that the Freedman device can print products. The most that the Freedman device can print is information about a printing job, not the job itself (column 10, lines 33-35, Figs. 1A and

1B). Sending printing job information to a printing facility is not the same as printing a job, especially in the professional printing industry.

To help Examiner better understand the nature of Applicant's claimed device, it may be helpful to explain Applicant's claimed device in the context of Freedman's disclosed device. In the context of Freedman's disclosure, Applicant's claimed invention would be used by a printing facility to format, typeset, layout, and put in place for production the data received from the central computer, a process that is not disclosed, contemplated, or accomplished by the Freedman device. It is critical for Examiner to understand this most basic and fundamental difference between Applicant's claimed invention and the Freedman disclosure—Applicant's invention formats and typesets a print job to put it in a condition where it can be produced by specialized, professional printing equipment without any additional human interaction.

The fully-formatted and typeset work which is produced by Applicant's device is in a final state ready to be immediately printed by professional printing machinery, while Freedman merely transmits to a printing facility the raw data for such a work, and the printing facility is left to manually format and typeset the work before it can be sent to printing machinery for production. Freedman's transmitting to a printing facility the underlying raw text and graphics, along with instructions on how the text and graphics should be formatted and typeset, is entirely different from creating a fully-formatted and typeset work which may be immediately printed by professional printing machinery. Thus, Freedman *cannot and does not print products.*

Freedman Does Not Produce Formatted Output

As further discussed below, Applicant respectfully traverses Examiner's continuing contention that Freedman produces formatted output, as read in light of Applicant's specification. Examiner cites to Freedman column 9, lines 64-67 and column 10, lines 19-35 in support of this position. For ease of reference, the cited portions of Freedman read:

> Once the computer is provided with all of the previously described information for the printing job, the computer calculates the total number of finished pages for the job and displays to the requester all publication design parameters need to produce the job in the manner selected. ... The requester is then provided with information regarding the various job costs, timing, etc. and is given the opportunity to select a particular printing facility or a particular machine or mix of machines for production

of the job. Once the selection is made, the requester authorizes the system to proceed with the printing job and all of the parameters and other information is transmitted by the computer to the appropriate printing facility and [sic] informs the requester that acceptance of the work by the printing facility forms a binding contract between the two parties. A printed verification of the parameters, prices, etc. is provided to the requester and the requester then logs off the system.

As clearly stated by the very Freedman disclosure cited by Examiner, what is sent to the printing facility is "parameters and other information" needed to proceed with the printing of job. Freedman does not state, imply, disclose, or suggest that any type of formatted output is produced by Freedman or transmitted to the printing facility. If Freedman did produce formatted output, then there would be no need to transmit the "printing parameters" to the print facility, since the print facility would already have the work in a formatted state. If Freedman produced formatted output, then why would the printing manager need to "enter the size and number of pages of the finished document, as well as the number of sides to be printed" as well as "the number of colors to be printed and the specific colors to be printed" (column 11, lines 21-25)? Such data would already be known if the printing facility had received formatted output. The answer is that Freedman simply does not produce or transmit formatted output. All formatting and typesetting of the work in Freedman's device is done independently by the printing facility after the printing data and parameters have been transmitted by Freedman.

Freedman Does Not Apply Formatting to Text and Graphics

Examiner contends that Freedman formats text and graphics. Applicant strenuously disagrees with Examiner on this critical issue. Freedman does not format text and graphics as specified in Applicant's Claim 1 read in light of Applicant's specification, as required by 35 U.S.C. § 112, further discussed below. Examiner contends that Freedman's "formatting" is done by the publication design specification and cites column 8, lines 56-67 as supporting this position. The relevant portion of the Freedman disclosure reads:

> The computer then gives the user the option of selecting a custom design format or utilizing publication design specifications which have been previously stored in the computer. If a custom design format is selected, the requester is then asked to enter the typeface selected for the main body of the text, the point size for the main body of the text, the character per pica count for the point size and typeface selected, the leading of the main body, the printing or typesetting device to be used, the page size

dimensions of the finished copy, the columns per page or special effects specifications, and depth of composition specifications.

However, a user's simply selection of such printing parameters is quite different from a device actually applying the parameters to the text and graphics of the work. Without any evidence or support for the proposition, Examiner writes off this critical misinterpretation of the Freedman device by concluding, simply, "[i]t can be shown that [sic] publication design specification performs the formatting of the manuscript information." Applicant believes that such *cannot be shown* since Freedman does not perform any formatting of the text and graphics it receives as read in light of Applicant's claims and Specification. Moreover, by failing to show precisely how Freedman actually formats text and graphics, Examiner cannot satisfy the initial burden of proof required to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Freedman Does Not Offer Means to Fully Populate Template

Examiner argues that the Freedman print manager's selection of "standard or floor stock" and the print manager's "ability to add additional information in the computer such as special stock dimension, color or plate size to complete the job" (column 11, line 36 to column 12, line 11) is the equivalent of Applicant's "means for automatically populating said populating data into said electronic graphic template further compris[ing] a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template." Respectfully, no support exists for Examiner's contention. The cited section of the Freedman specification contains no mention of a template or a means to fully populate the template should the populating data not fully populate the template. In fact, there is no data in the entire Freedman patent to suggest that any template used by the Freedman device to accept text or graphics from the print requester is even transmitted to the print facility. Therefore, there is no reason to believe that Freedman's print manager uses any type of template when working on a print job. Thus, there simply is no support for Examiner's position on this issue.

Conclusion

As noted above, Applicant has offered the preceding comments to better help Examiner recognize the differences between the Freedman device and Applicant's claimed invention, to

complete the record, and to preserve its rights on appeal. With these comments Applicant is not waiving, and specifically reserves, its right to further object to these issues in the future.

Claim Rejections – 35 U.S.C. § 103

Applicant respectfully traverses Examiner's continued rejection of Claims 1 – 5 and 7 – 9 under 35 U.S.C. § 103(a) obvious and unpatentable in light of Freedman. Examiner is requested to reconsider and withdraw the rejections in light of the following arguments.

Claim 1

Applicant's Claim 1, read in light of Applicant's Specification as required under 35 U.S.C. § 112 6th Paragraph, includes specific, positive limitations that are not taught or suggested by Freedman. Examiner has not met the burden of proving a *prima facie* case of obviousness for Claim 1.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id. citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to the final criterion, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka* , 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson* , 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP § 2143.03.

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined." MPEP § 2141 *citing Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of non-obviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art." MPEP § 2141.

When interpreting Applicant's claims, it is crucial for Examiner to determine the scope and meaning of any "means plus function" language by referring to Applicant's Specification. "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112. When a claim is expressed using means plus function language, an examiner is required to examine an applicant's specification to determine the proper scope and definition of claim element. *See id.* Here, Applicant's Claim 1 comprises, *inter alia*, "a means for automatically formatting said populating data on said electronic graphic template according to said customer's corporate identity specifications to form a populated and formatted template."

As discussed in Applicant's prior amendments, and as repeatedly disregarded by Examiner, Applicant's intended meaning of this key phrase, "a means for automatically formatting said populating data on said electronic graphic template according to said customer's corporate identity specifications to form a populated and formatted template," is clearly found in the Specification:

After the populating data is entered into the first block of the template, the various design specifications for that block, such as kerning, leading, font styles, font sizes, colors, etc., are adjusted. This is accomplished by programming the design specification commands into the Database File Program's calculation field. Using the appropriate PageMaker commands, such as "select," "textedit," "textselect," "font," "sizebump," "KernText," and "Color," as shown in the BCard01 calculation field in Fig. 7 and in the appended unabridged sample Database File Program, FileMaker Pro instructs PageMaker to select the appropriate x-and-y coordinates of the block that needs to be adjusted, resets PageMaker into a text edit mode, and transmits to PageMaker the commands necessary to complete the desired formatting. For example, to set the kerning for a given text block, PageMaker is instructed by FileMaker Pro to set the cursor within the appropriate text block (identified by its x-and-y coordinates), highlight the text that needs to be kerned, and adjust the kerning as required. The design parameters are based on a customer's corporate identity specifications as programmed into the Database File Program.

The present invention can set any formatting that a human operator could set manually. The great advantage is that a human operator could accidentally move or change something incorrectly, where the present invention cannot—it only moves or adjusts the data it is programmed to change.

When the first set of x-and-y coordinates have been fully populated and formatted, Database File Program's calculation field is programmed to continue on to the x-and-y coordinates of the next block on the template and perform the identical functions as stated above for the populating of the block and the formatting of the populating data according to the programmed design specifications. Once all of the populating data from the first found record is populated and formatted, the Template Populating Script instructs FileMaker Pro to move on to the next found record and to repeat the process for the next set of blocks on the template (for

example, BCard02), as shown in Fig. 7 and in the appended unabridged sample Template Populating Script. Only after all of the populating data from all of the found records have been fully populated with all formatting design specifications followed, is PageMaker instructed by FileMaker Pro (using the "printoptionsps" and "print" commands, as shown in Fig. 14) to send the template direct to the appropriate device, either directly connected or connected over a computer network using standard, prior art networking technology, for the manufacture of production-ready plates or films. (Specification, pages 15 – 16).

Since Applicant's Claim 1 obviously invokes 35 U.S.C. § 112 6th Paragraph, Examiner is required to revert to Applicant's Specification to determine the proper scope and meaning of "means for automatically formatting said populating data on said electronic graphic template according to said customer's corporate identity specifications to form a populated and formatted template." Based on the above cited portion of Applicant's Specification, it is clear that Examiner's cite to Freedman column 8, lines 40-44 does not disclose an identical or equivalent process as described in Applicant's Specification. If Applicant's claimed "means for automatically formatting said populating data on said electronic graphic template according to said customer's corporate identity specifications to form a populated and formatted template," as interpreted under 35 U.S.C. § 112, 6th Paragraph, was disclosed in Freedman, then where in Freedman is the comparable description of the formatting process as set forth in Applicant's Specification on pages 15-16?

Examiner contends that Freedman, in column 8, lines 40-44, discloses an identical or equivalent process. For ease of reference, the cited Freedman language reads:

> The computer provides the requester with a number of possible formats which could be selected. The formats made available for selection are typical of those employed in the printing industry or to a particular customer or type of work.

However, as discussed above, Examiner's misreading of the Freedman disclosure accords it far more breadth that it is actually entitled and ignores the clear differences between the Freedman disclosure and Applicant's Claim 1 as properly read in light of the relevant portions of Applicant's Specification.

Freedman allows a user to select a format (book, newsletter, etc.) in which the final work will appear. Selecting a format for a work is not the same as a "means for automatically formatting said populating data on said electronic graphic template according to said customer's corporate identity specifications to form a populated and formatted template," as read in light of Applicant's Specification. Importantly, *Applicant is not claiming a "means to select a format."* Allowing a user to select a "manuscript status format [noun]" (Freedman, column 8, lines 36 – 44) or collecting from a user "custom design format [noun]" information (Freedman, column 8, lines 56 – 68, previously cited by Examiner) are not means for automatically formatting [verb] as claimed by Applicant's Claim 1 read in light of Applicant's specification. Freedman's device does not format [verb]; it permits the selection of a format [noun]. Moreover, even if, for sake of argument, Freedman could and did format, there is absolutely no disclosure in Freedman that teaches or suggests that any such formatting is done automatically, another important limitation of Applicant's Claim 1. These limitation is not taught or suggested by Freedman.

Applicant and Freedman use similar words ("template" and "format") to describe different elements of related processes. It is crucial that Examiner read the disclosures carefully and assign the correct meanings the words. Simply because the word "format" [noun] appears in the Freedman disclosure does not mean that Freedman "formats" [verb]. The fact of the matter is that Freedman collects formatting parameters, such as typeface, point size, characters per pica count, leading, and the like, as described in column 8, lines 56 – 68. However, Freedman does not apply the formatting parameters to the text or graphics it receives. Instead, Freedman only uses the formatting parameters that it collects as variables in a formula to calculate "cost information utilizing alternate pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities," to provide "information regarding the various job costs, timing, etc.," and to give a user "the opportunity to select a particular printing facility or a particular machine or mix of machines for production of the job." (Freedman, column 10, lines 16-24).

Freedman teaches no means for automatically formatting populating data on an electronic graphic template according to a customer's corporate identity specifications to form a populated and formatted template. Applicant can find no disclosure in Freedman analogous to Applicant's above-described (Specification, pages 15 – 16) automated means of selecting unformatted data on an electronic graphic template, applying the appropriate formatting to the unformatted data according to a customer's corporate identity specifications, and similarly automatically selecting and automatically formatting the next unformatted data on the electronic graphic template until all unformatted data has been appropriately formatted according to the customer's corporate identity specifications. Therefore, at a minimum, these limitation of Applicant's Claim 1 are not taught or suggested by Freedman and, thus, the claim is nonobvious and allowable.[1]

Claim 2

Applicant respectfully traverses Examiner's rejection of Claim 2 as obvious in light of Freedman under 35 U.S.C. § 103(a). First, Claim 2 depends from a nonobvious independent base claim, Claim 1, and therefore itself is nonobvious. Additionally, Applicant's Claim 2, read in light of the relevant portions of Applicant's Specification as required under 35 U.S.C. § 112 6th Paragraph, includes limitations that are not taught or suggested by Freedman. Therefore, Examiner has not met the burden of proving a *prima facie* case of obviousness for Claim 2.

As discussed above, a *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. With regard to the final criterion, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re*

---

[1] Applicant further notes that Examiner has not offered any evidence or argument regarding the two remaining criteria required to prove a *prima facie* case of obviousness: a suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching; and, a reasonable expectation of success. Therefore Examiner has failed to meet the burden of proving a *prima facie* case of obviousness for Claim 1.

Royka , 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03; *see also* 37 C.F.R. 1.75(c) ("claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim"). Finally, when a claim is expressed using means plus function language, an examiner is required to examine an applicant's specification to determine the proper scope and definition of claim element. *See* 35 U.S.C. § 112.

Applicant's Claim 2 is a dependent claim based on independent Claim 1. Claim 1, as previously discussed, is nonobvious in light of Freedman and allowable. Since Claim 2 depends from nonobvious Claim 1, then Claim 2 also is nonobvious and allowable. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03.

Moreover, Applicant's Claim 2 is nonobvious because all of the claim limitations are not taught or suggested by Freedman. Specifically, Applicant's Claim 2 comprises, *inter alia*, "a means for automatically producing production-ready output using said populated and formatted template to produce said commercially-printed product." Applicant's intended meaning of this limitation, " a means for automatically producing production-ready output using said populated and formatted template to produce said commercially-printed product," is found in the Specification:

> Only after all of the populating data from all of the found records have been fully populated with all formatting design specifications followed, is PageMaker instructed by FileMaker Pro (using the "printoptionsps" and "print" commands, as shown in Fig. 14) to send the template direct to the appropriate device, either directly connected or connected over a computer network using standard, prior art networking technology, for the manufacture of production-ready plates or films. (Specification, pages 15-16).

Since Applicant's Claim 2 obviously invokes 35 U.S.C. § 112 6th Paragraph, Examiner is required to revert to Applicant's Specification to determine the proper scope and meaning of " a means for automatically producing production-ready output using said populated and formatted template to produce said commercially-printed product." Based on the above cited portion of Applicant's Specification, it is clear that Examiner's cite to Freedman column 7, lines 58-61 and

column 8, lines 45-48 does not disclose an identical or equivalent process as described in Applicant's Specification. For ease of reference, the cited Freedman language reads:

> As will hereinafter be described, the stored information is essentially transmitted to a printing facility through a second or printing facility terminal 36, 46, or 58 for printing of the work. ... The requester has two options. The requester can batch load the entire manuscript in the computer in the desired form, thereby skipping over several of the below-discussed steps[2].

Examiner's contention that Freedman discloses "a means for automatically printing said populated and formatted template [sic]" is incorrect. Freedman (Column 7, lines 58-61) makes a general statement about transmitting the data and parameters it has received to a third-party printing facility. Transmitting text, graphics, and layout and formatting parameters to a third-party printing facility is not equivalent of automatically producing production-ready output as read in light of the above cited portion of Applicant's Specification. In Applicant's device, the fully-formatted and typeset work is transmitted *directly to the appropriate printing machine* with no further need for human interaction or supervision. Much to the contrary, Freedman's device merely sends the raw, non-formatted and non-typeset print work data, along with instructions on how the data is to be format and typeset, to a printing facility, not a printing machine, where a human printing manager is required to format and typeset the print work and direct it to the appropriate printing machine (Freedman column 11, line 11 through column 12, line 43). Freedman therefore does not *automatically* produce production-ready output which is transmitted *directly* to the appropriate printing machine. This limitation of Applicant's Claim 2 is not taught or suggested by Freedman and, thus, the claim is nonobvious and allowable.

Again, Applicant further notes that Examiner has not offered any evidence or argument regarding the two remaining criteria required to prove a *prima facie* case of obviousness: a suggestion or motivation, either in the reference itself or in the knowledge generally available to one

---

[2] Applicant questions the relevancy of Examiner's citation to Freedman column 8, lines 45-48 ("The requester has two options. The requester can batch load the entire manuscript in the computer in the desired form, thereby skipping over several of the below-discussed steps.") in this matter. The cited Freedman disclosure appears to have nothing to do with Applicant's claimed "means for automatically producing production-ready output using said populated and formatted template to produce said commercially-printed product" as read in light of Applicant's Specification.

of ordinary skill in the art, to modify the reference or to combine reference teaching; and, a reasonable expectation of success. Therefore Examiner has failed to meet the burden of proving a *prima facie* case of obviousness for Claim 2.

Claims 3-5, 7, and 9

Applicant respectfully traverses Examiner's rejection of Claims 3-5, 7, and 9 under 35 U.S.C. § 103(a) as obvious in light of Freedman and requests Examiner reconsider.

Dependent Claims 3-5, 7, and 9 claim the automated typesetting system as recited in Claims 1 or 2. As discussed above, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03; *see also* 37 C.F.R. 1.75(c) ("claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim"). Applicant's Claims 1 and 2 are not obvious in light of Freedman since Freedman does not teach each and every claim limitation of Claims 1 and 2. Therefore, Freedman does not teach each and every element of dependent Claims 3-5, 7, and 9 and Claims 3-5, 7, and 9 cannot be obvious in light of Freedman . Thus, Claims 3-5, 7, and 9 are allowable.

Claim 8

Applicant respectfully traverses Examiner's rejection of Claim 8 as obvious in light of Freedman under 35 U.S.C. § 103(a). First, Claim 8 depends from nonobvious base claims, Claims 1 or 2, and therefore itself is nonobvious. Additionally, Applicant's Claim 8, read in light of the relevant portions of Applicant's Specification as required under 35 U.S.C. § 112 6th Paragraph, includes limitations that are not taught or suggested by Freedman. Therefore, Examiner has not met the burden of proving a *prima facie* case of obviousness for Claim 8.

As discussed above, a *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. [3] Finally,

---

[3] Again, Applicant notes that Examiner has not offered any evidence or argument regarding the first two criteria required to prove a *prima facie* case of obviousness: a suggestion or motivation, either

the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. With regard to the final criterion, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka* , 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03; *see also* 37 C.F.R. 1.75(c) ("claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim"). Finally, when a claim is expressed using means plus function language, an examiner is required to examine an applicant's specification to determine the proper scope and definition of claim element. *See* 35 U.S.C. § 112.

Applicant's Claim 8 is a dependent claim based on Claims 1 or 2. Claims 1 and 2, as previously discussed, are nonobvious in light of Freedman and allowable. Since Claim 8 depends from nonobvious Claims 1 or 2, then Claim 8 also is nonobvious and allowable. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03.

Moreover, Applicant's Claim 8 is nonobvious because all of the claim limitations are not taught or suggested by Freedman. Specifically, Applicant's Claim 2 comprises, *inter alia*, "a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template."

Applicant's intended meaning of this limitation, "a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template," is found in the Specification:

> In the event that the number of found records in a customer's database file does not match the available space on the appropriate template, the system will compensate to ensure the most efficient production run. For example, if multiple found records exist, and the total count exceeds the number of set x-and-y coordinates on the appropriate template, FileMaker Pro instructs PageMaker to populate the first template as stated above and then instructs PageMaker to open subsequent templates

in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching; and, a reasonable expectation of success. Therefore Examiner has failed to meet the burden of proving a *prima facie* case of obviousness for Claim 8.

until all records in the found set are populated on templates, as shown in Fig. 15, the Template Format Scripts.

Similarly, if the number found records is of an odd number, in which the whole template cannot be populated, the Template Format Scripts instruct FileMaker Pro to duplicate records or make a dummy records as appropriate to finish the process. An example of the preferred embodiment of this process is shown in Fig. 15. Examples of the process are explained below.

If the production will be engraving printed on a three-up plate, the programming ensures that FileMaker Pro properly populates the appropriate template as follows. When the number of found records to be printed is equal to one, four, seven or ten, FileMaker Pro is programmed to duplicate the last record two times to make a complete three-up plate of that record. If the number of sets is equal to two, five, eight or eleven, FileMaker Pro is programmed to create a dummy blank record to complete the three-up plate.

The same philosophy applies to lithography orders. For instance, if a lithographic plate accommodates thirty business cards running five-up, FileMaker Pro is programmed to perform counts based on multiples of five to properly populate the appropriate template with minimum waste. If the number of sets is one, it would populate the whole plate by itself. For a count of two, FileMaker Pro duplicates the first record fourteen times and duplicates the second record fourteen times, sorts the records by name so the records would be properly placed together, and then populates the template. For a count of three, each record is duplicated nine times, then sorted by name so the records would be properly placed together when populating the template. A count of four would result in duplication the each of the four records six times, and creation of two dummy records.

Similarly, a count of five would duplicate the first five records five times. A count of six would duplicate the first six records four times. A count of seven would duplicate the first seven records three times each then create two dummy records. A count of eight would duplicate the first eight records two times each then create six dummy records. A count of nine would duplicate the first nine records two times each then create three dummy records. A count of ten would duplicate the first ten records two times each. A count of eleven would duplicate the first eleven records one time each then create eight dummy records. A count of twelve would duplicate the first twelve records one time each then create six dummy records. A count of thirteen would duplicate the first thirteen records one time each then create four dummy records. A count of fourteen would duplicate the first fourteen records one time each then create two dummy records. A count of fifteen would duplicate the first fifteen records one time each. If the number of sets is greater then fifteen but less than thirty, one dummy record is created to fill up the production plate. The Template Format Scripts programming creates a production fail-safe system in that an order will not be produced in excess, while production materials such as film, plates, and stock are saved. (Specification, pages 16-17).

Since Applicant's Claim 8 obviously invokes 35 U.S.C. § 112 6th Paragraph, Examiner is required to revert to Applicant's Specification to determine the proper scope and meaning of " a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template." Based on the above cited portion of Applicant's

Specification, it is clear that Examiner's cite to Freedman column 11, lines 36-38 and column 8, lines 45-48 do not disclose an identical or equivalent process as described in Applicant's Specification. For ease of reference, the cited Freedman language reads:

> The printing manager then selects whether a standard or floor stock is to be used, based upon a recommendation made by the network, or whether a special stock is to be used in the job.

Examiner's contention that Freedman discloses "a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template" simply is incorrect and is not supported by the record. While Examiner may argue that the Freedman print manager's selection of "standard or floor stock" and the print manager's "ability to add additional information in the computer such as special stock dimension, color or plate size to complete the job" (column 11, line 36 to column 12, line 11) is the equivalent of Applicant's "means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template," clearly such as not the case when Applicant's Claim 8 is properly interpreted by the relevant portion of Applicant's Specification. Applicant can find no support for Examiner's contention. The cited section of the Freedman specification contains no mention of a template or a means to fully populate the template should the populating data not fully populate the template. Examiner has not satisfied the burden of proving a *prima facie* case of obviousness and Claim 8 therefore is nonobvious and allowable.

Claim 6

Applicant respectfully traverses Examiner's rejection of Claim 6 under U.S.C. § 103(a) as obvious based on Freedman in view of Cupps et al. (U.S. Patent 5,991,739). First, Claim 6 depends from nonobvious base claims, Claims 1 or 2, and therefore itself is nonobvious. Additionally, Examiner has not met the burden of proving a *prima facie* case of obviousness for Claim 6.

As discussed above, a *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. With regard to the final criterion, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka* , 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03; *see also* 37 C.F.R. 1.75(c) ("claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim").

Applicant's Claim 6 is a dependent claim based on Claims 1 or 2. Claims 1 and 2, as previously discussed, are nonobvious in light of Freedman and allowable. Since Claim 6 depends from nonobvious Claims 1 or 2, then Claim 6 also is nonobvious and allowable. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03.

Additionally, Examiner has failed to prove a *prima facie* case of obviousness. Examiner has not offered any evidence or argument regarding the first two criteria required to prove a *prima facie* case of obviousness: a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings; and, a reasonable expectation of success. Examiner merely concludes, without any support or substantiation, that it would have been obvious to combine the teachings of Freedman and Cupps. Such naked, conclusory statements do not meet Examiner's initial burden of proving a *prima facie* case of obviousness for Claim 6. Therefore, Claim 6 is allowable.

EVIDENCE OF COMMERCIAL SUCCESS

Although Applicant does not believe that Examiner has made a *prima facie* showing of obviousness for any of the claims in this application, in a good faith effort to move this case towards a resolution, and without waiving its right to further object to the adequacy of Examiner's obviousness rejections, Applicant offers the following evidence of the commercial success of Applicant's claimed invention. Applicant's submission of evidence of the commercial success of its

claimed invention should not in any way be deemed an admission by Applicant that Examiner has proved a *prima facie* case of obviousness.

"Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence." MPEP § 2141. The commercial success of the Automated Typesetting System as claimed in independent Claim 1, proves that Claim 1 is nonobvious and, therefore, dependent Claims 2-9 are nonobvious.

As discussed in the enclosed Affidavit of Commercial Success Under 37 C.F.R. § 1.132 (the "Fontana Affidavit"), Applicant's Automated Typesetting System as claimed in Claim 1 has met with remarkable commercial success since it was put into use in October 1997 (Fontana Affidavit, ¶13). But, before examining the commercial success of the present invention, it is important to understand the inefficiencies of the prior art to help establish a baseline for the claimed invention's commercial success. Under traditional prior art production systems, orders for printed products were typically first received by order processing personnel (Fontana Affidavit, ¶7). Then, following initial processing, the orders would be directed to typesetting experts for typesetting scheduling, and then to pre-press for formatting, layout, and set-up to be put in position for production. *Id.*

Typically, orders would be scheduled for typesetting within a day or two after receipt, depending on backlog Fontana Affidavit, ¶8). The typesetting expert would review the order, manually enter the information from the order into a template (a template contains a customer's specific product layout information based on the customer's corporate identity specifications), manually adjust fonts, sizing, kerning, colors, and the like where necessary, and print out the draft typeset order for a proofreader's review. *Id.* The proofreader would then isolate any typographical errors or formatting changes required by the customer's corporate identity specifications, and send those changes back to the typesetter for corrections. *Id.* The typesetter would then manually correct

the order. *Id.* Once the corrections were made, the order would again be printed and reviewed a second time by the proofreader. *Id.* If the proofreader determined that all of the customer's corporate identity specifications had been met and no typographical errors existed, the order was transmitted to the customer for approval. *Id.*

Often times, after customer review, changes would need to be made due to poor fax quality, or because the typesetter or proofchecker overlooked an error (Fontana Affidavit, ¶9). This time-consuming typesetting and proofing cycle was repeated until the order was approved by the customer and no further changes were required. *Id.* Once the final approval was received, the order would be sent on to the printing department for preparation of the production plate or film. *Id.* At its fastest, the entire process would typically take a minimum of three business days, and if further information was changed by the customer during the approval process, it would take even longer. *Id.* Therefore, preparation of a single engraved business card order under using traditional prior art methods, for example, from receipt of order to creation of engraving production plate, may have taken anywhere from 3 to 5 days, or longer, with multiple and repeated levels of detailed, human proofing, and therefore, high overhead and increased consumer cost. *Id.*

In addition to increased overhead and consumer cost, the extensive and repeated human supervision required under traditional prior art systems introduced multiple opportunities for error (Fontana Affidavit, ¶10). The Automated Typesetting System claimed in Claim 1 was conceived and designed to eliminate the inefficiencies in the prior art process described above (Fontana Affidavit, ¶11).

The commercial success of the Automated Typesetting System claimed in Claim 1 can be measured in various ways (Fontana Affidavit, ¶14). For example, the Automated Typesetting System claimed in Claim 1 has reduced the average production time for commercially printed products, such as business cards, envelopes, and stationery, from approximately 3 to 5 days to 1 day or less (Fontana Affidavit, ¶15). In the printing industry, reduced production time means higher efficiency and higher production capacity. *Id.* Moreover, it means increased customer satisfaction since customers receive order produced using the Automated Typesetting System claimed in Claim

1 much sooner than they would from a competitor who does not use the invention. *Id.* Such customer satisfaction and goodwill is invaluable and cannot be quantified. *Id.*

The Automated Typesetting System claimed in Claim 1 also has resulted in cost savings through printing production staff reductions (Fontana Affidavit, ¶16). What once took several employees to format, layout, setup, put in place for production, and typeset a print job for a commercially printed product now is automatically accomplished by the Automated Typesetting System claimed in Claim 1. *Id.* This has saved approximately $250,000 in annual payroll costs. *Id.*

Quite importantly in light of the prior art, the Automated Typesetting System claimed in Claim 1 has nearly eliminated errors in the production process (Fontana Affidavit, ¶17). Since print jobs are automatically formatted according to a customer's corporate identity specifications, the element of human error in the prior art production process has been virtually eliminated. *Id.* This has saved approximately $100,000 in annual costs for re-runs due to errors. *Id.*

But perhaps the strongest evidence of the commercial success of the Automated Typesetting System claimed in Claim 1 is the remarkable increase in orders and sales once the claimed system was put into use (Fontana Affidavit, ¶18). Orders for commercially printed products based on a customer's corporate identity specifications, such as business cards, envelopes, and stationery, using the Automated Typesetting System claimed in Claim 1 have increased dramatically since the system put into use October 1997 (Fontana Affidavit, ¶19). Total orders using the Automated Typesetting System claimed in Claim 1 rose from 6,744 in 1997, to 60,477 in 1998, to 72,648 in 1999, to 160,740 in 2000 (Fontana Affidavit, ¶20). This represents a nearly 2400% increase in orders over three years. *Id.* During the same period, 1997 through 2000, total dollar sales of orders using the Automated Typesetting System claimed in Claim 1 rose approximately 1400%. *Id.* It is believed that the increased orders and sales are directly attributable to use of the Automated Typesetting System claimed in Claim 1. *Id.*

Applicant's Automated Typesetting System as claimed in Claim 1 has met with undeniable commercial success. Had Examiner proven a *prima facie* case of obviousness for Claim 1, it is clear
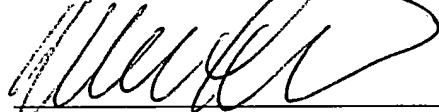
that the level of commercial success of the claimed invention far outweighs any alleged obviousness. Claim 1, and dependent Claims 2-9, therefore are nonobvious and allowable.

CONCLUSION

With this Amendment, Applicant believes that the application is in condition for allowance and a prompt issuance of the Notice of Allowability is respectfully requested.

August 25, 2004   Respectfully submitted,

Marc E. Fineman, ext 23
PTO Reg. 41,746
Attorney for Applicant
KEGAN & KEGAN, LTD.
79 West Monroe St. #1320
Chicago, IL 60603-4969
/WD/mef/v6587   312•782-6495; Fax 312•782-6494